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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/196,200	11/20/98	FARMWALD	M P043D2C1

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EXAMINER

NGUYEN, T

ART UNIT

PAPER NUMBER 4

2818

DATE MAILED:

03/17/99

#4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/196,200

Applicant(s)

FARMWALD et al.

Examiner

TAN T. NGUYEN

Group Art Unit

2818

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/20/98.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 151-176 is/are pending in the application.
Of the above claim(s) 1-150 is/are withdrawn from consideration.
- ☒ Claim(s) 157-163 is/are allowed.
- ☒ Claim(s) 151-156, 164-176 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The proposed drawing correction, filed on 4/20/98 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number)
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received:

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other

Office Action Summary

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1. The following action is in response to the Preliminary Amendment filed by Applicants on November 20, 1998.

2. Claims 1-150 have been canceled.

New claims 151-176 have been added.

3. The Request to approve drawing changes filed by Applicants on November 20, 1998 has been approved.

4. Claims 168-176 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the disclosure is not enabling for the entire scope of the claims 168, which recites a method comprising a single step, a functional statement of intended result, and thus additionally fails to distinctly claim any subject matter. 35 U.S.C § 112, sixth paragraph, does not permit such a claim construction. Accord, *In re Hyatt*, 708 F.2d 712 (CAFC, 1983).

5. Claims 152-156 and 164-167 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 152-154 and 165-166, it is not clear how the delay time is stored in the register after the power is applied to the memory device or the memory device is reset or when the memory device is initialized.

In claim 164, it is not clear how the drivers output data on a bus in accordance with the delay time.

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In claims 155-156 and 167, it is not clear what the set register request is, and how the delay time is stored in the programmable register in response to the set register request.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 151 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,841,580. Although the conflicting claims are not identical, they are not patentably distinct from each other because the bus transaction request would include the read request.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cline et al. is cited to show an apparatus for programmable interval timing generator in semiconductor memory having programmable delay apparatus.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan T. Nguyen whose telephone number is (703) 308-1298. The examiner can normally be reached on Monday to Friday from 08:00 AM to 04:00 PM.

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03/26/99

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David C. Nelms, can be reached on (703) 308-4910. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Tan T. Nguyen
Primary Examiner
Art Unit 2818
March 05, 1999

T.N
03/05/99